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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,599	02/05/2002	Robert H. Dahla	CB-11	2789

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EXAMINER

HAYES, MICHAEL J

ART UNIT PAPER NUMBER

3763

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/072,599

Applicant(s)

DAHILA ET AL.

Examiner

Michael J. Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 25-83 is/are pending in the application.
- 4a) Of the above claim(s) 13, 15-22, 28-36 and 38-82 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 25, 27, 37 and 83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of group I and species 10 drawn to fig. 16B in the reply filed on 10/22/04 is acknowledged.

Claims 13, 15-22, 28-36, and 38-82 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and/or species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/22/04.

This application contains claims 13, 15-22, 28-36, 38-82 drawn to an invention nonelected with traverse in Paper received 10/22/04. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 3, 6, 7, 8, 10, 11, 12, 37, and 83 are rejected under 35 U.S.C. 102(e) as being anticipated by RYAN (US Patent No. 6,280,441). Ryan discloses an electrosurgical probe including a return electrode coil 22 with gaps, and active electrode 17 within a void of the return

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coil, and a connection block for coupling the probe to a power supply (6:50-58). The return electrode coil has about 6 turns, is parallel to the longitudinal axis of return electrode filament, the wire distal terminus is part of (i.e., within) the coil, the first turn is at the distal end (whether the first turn is considered at the distal or proximal end is merely a matter of whether counting starts at the distal or proximal end), and an insulating spacer 26 proximal to the electrode head (See figs. 3, 5; col:lines 3:26-40, 6:31-58). The spacer is surrounded by the return electrode (6:31-35). The active electrode filament is substantially linear due to its overall configuration within the device. See fig. 1 and 6:50-61 where the proximal portion of the device is described as rather long portion and therefore the linear filament through this portion would be substantial. As the distal portion of the active electrode filament is shown coiled and the portion through the shank 36 is shown linear (fig. 22). The active electrode head is seen as the tip of the active electrode filament.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, 9, 14, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over RYAN in view of GOBLE (US Patent No. 5,891,134). Ryan discloses the claimed invention as discussed above except for the helix pitch of 0.01-0.045in., electrode coil external diameter 0.07-0.2 in., return electrode filament diameter 0.008-0.03 in., active electrode filament

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diameter 0.006-0.02 in., ceramic insulating spacer, and handle housing the connection block.

Goble teaches the use of a ceramic insulating spacer and handle housing the connection block. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Goble in the probe of Ryan in order to use a well-know material for insulation and to obtain an efficient device that is easy to use by having the handle house the connection. With respect to claims 4, 5, 9, 14 it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the probe disclosed by Ryan to the claimed dimensions because Applicant has not stated that these dimensions are for a stated purpose or to solve a particular problem and it appears other dimensions would work equally as well. Applicant has not supplied any criticality with respect to these dimensions and they are merely design choice.

Claims 24 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over RYAN in view of COHEN (US Patent No. 4,832,048). Ryan discloses the claimed invention except for making the insulating member of alumina and the electrodes of titanium. Cohen teaches to use these materials for insulation and for the electrodes. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Cohen in the probe of Ryan in order to make an electrosurgical probe using common, well-known materials for insulation and electrodes.

Response to Arguments

Applicant argues that Ryan does not disclose a substantially linear active element with a return electrode distal terminal portion configured into a coil around the active electrode element. The examiner disagrees because in fig. 3 and in the specification at 6:31-35 the return electrode

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22 is shown and described as a coil having turns around a spacer 26 and substantially linear active electrode 17. The active electrode is substantially linear, as seen in figs. 1 and 3 because the distal portion is described as a coil, but the proximal portion through the device is linear. Since only the distal portion is coiled, the active electrode filament is considered substantially linear.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Hayes at (571) 272-4959. The examiner can usually be reached Monday -Thursday, 7:00-4:30, and on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi, can be contacted at (571) 272-4977. The fax number for submitting official papers is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mjh
31 May 2005



MICHAEL J. HAYES
PRIMARY EXAMINER